

REMARKS

The following remarks are provided in response to the Final Office Action dated May 3, 2004 in which the Examiner:

- rejected claims 1-14 and 21-27 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 6,480,853 to Jain in view of United States Patent No. 5,963,915 to Kirsch.

The applicant respectfully request reconsideration of the above referenced patent application in view of the amendments and remarks set forth herein, and respectfully requests that the Examiner withdraw all rejections.

35 U.S.C. §103(a)

The Examiner rejected claims 1-14 and 21-27 under §103(a) as being unpatentable over Jain in view of Kirsch. For at least the foregoing reasons, the applicants respectfully assert that they have overcome the rejection and respectfully request that the Examiner allow claims 1-14 and 21-27.

A *prima facie* case of obviousness under 35 U.S.C. §103 requires, among other criteria, that “. . . the prior art reference (or references when combined) must teach or suggest **all** the claim limitations.” (emphasis added) (See M.P.E.P. 706.02(j) and 2143.03). To overcome a §103(a) rejection, the applicant must only demonstrate that the cited prior art document or documents fail individually and in combination to teach or suggest one element or limitation present in the claim. Further, “[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated [by the Examiner] as nearly as practicable.”

(See M.P.E.P. §706 citing 37 C.F.R. §1.104(c)(2)).

The salient portion of currently amended independent claim 1 recites:

generating a set of one or more common search requests for subsets of the product data **based on the frequency of previously received search requests and designation of a search request as a common search request;**
(emphasis added)

Independent claims 8 and 21 recite a similar limitation. The Examiner alleges that the Jain abstract, Figure 2, and column 4, lines 1-42 teach generating a set of one or more common search requests for subsets of the product data. The Examiner further alleges with respect to claim 5, an element of which has been included in independent claim 1, that Jain Figure 3 and column 5 line 19 bridging column 6 line 64 teaches one or more common search requests including one or more frequently performed searches. The applicant disagrees with both of the Examiner's allegations.

The Jain abstract discloses that “[a] search engine receiving the search request and accompanying list of bookmarks initially searches the list of bookmarks for URLs that satisfy the search request.” Column 4, lines 1-42 merely discuss the elements of Figure 2 (a figure limited to the elements “web site,” “web server / search engine,” “Internet / intranet,” and “client device.”) both of which fail to include any specificity directed to, among other elements recited by independent claim 1, a common search request. The applicant asserts that searching a list of bookmarks, **that by definition are manually created by the user browsing the Internet or intranet and are unique to the particular user**, cannot teach generating a set of one or more common search requests as recited by independent claim 1.

Jain Figure 3, and column 5 line 19 bridging column 6 line 64 further detail

searching the list of bookmarks for URLs that satisfy the search request. In particular, column 5 line 35 bridging column 6 line 3 accompany the flow chart illustrated by Figure 3. “If a user wants his or her bookmarks to be searched, the search engine searches the received list of bookmarked URLs for Web pages (or other files) identified by each respective URL that satisfy the search request. . . .” Further, “[p]referably, a user sends a list of his or her bookmarks to a search engine as a cookie or as a Multi-Purpose Internet Mail Extension (MIME) attachment.” Again, the applicant asserts that the list of bookmarks is unique to the user (as the user is the exclusive source of the bookmarks) and cannot therefore teach a common search request as recited by independent claim 1. The cited portions of Jain further fail to teach that the common search request is based on the frequency of previously received search requests and designation of a search request as a common search request as recited by independent claim 1.

Accordingly, the applicant respectfully asserts that independent claims 1, 8 and 21 recite at least an element not taught by Jain in view of Kirsch (the Examiner did not rely on Kirsch to reject the independent claim element emphasized above) and requests that the Examiner allow independent claims 1, 8, and 21. The applicant further affirms that dependent claims 2-4, 6-7, 9-11, 13-14, 22-24, and 26-27 are patentable as each depends from a nonobvious independent claim. (See M.P.E.P. §2143.03 (citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988))).

CONCLUSION


For at least the foregoing reasons, the applicant submits that he has overcome the Examiner's rejections and that he has the right to claim the invention as set forth in the listed claims. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN, L.L.P.

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Dated


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